

Appl. No. : 10/764,012  
Filed : January 23, 2004

### REMARKS

Upon entry of this Amendment, claims 1-9, and 28-47 will be pending in this application. The remaining claims have been filed in divisional applications, and have thus been canceled.

Applicant has amended the specification to include the serial number of the copending U.S. Patent Application. No new matter has been added with this amendment.

Applicant has amended claim 1 to recite that the second, lower molecular weight, polyol forms a polyurethane that is less rigid than that formed by the first, higher molecular weight polyol as disclosed in the specification at page 7, lines 21-23. Since the polyols themselves are liquid as noted on page 8, lines 3-5, one of skill in the art would recognize that it is the polyurethane formed by the polyol that is more or less rigid.

New claim 28 is supported by the specification at page 3, lines 21-22.

New claim 29 is supported by the specification at page 10, lines 18-20.

New claim 30 is supported by the specification at page 11, line 20 to page 12, line 2.

New claim 31 is supported by claim 1 as originally filed.

New claim 32 is supported by the specification at page 6, lines 1-5.

New claim 33 is supported by the specification at page 7, lines 3-5.

New claim 34 is supported by the specification at page 7, lines 3-5.

New claim 35 is supported by the specification at page 7, lines 5-7.

New claim 36 is supported by the specification at page 7, lines 5-7.

New claim 37 is supported by the specification at page 7, lines 11-13.

New claim 38 is supported by the specification at page 7, lines 11-13.

New claim 39 is supported by the specification at page 7, line 23 to page 8, line 3.

New claim 40 is supported by the specification at page 7, line 23 to page 8, line 3.

New claim 41 is supported by the specification at page 15, line 18.

New claim 42 is supported by the specification at page 8, lines 5-7.

New claim 43 is supported by the specification at page 15, lines 10-23.

New claim 44 is supported by originally filed claim 1 and by the specification at page 8 lines 5-7.

New claim 45 is supported by originally filed claim 1 and by the specification at page 15, line 20 and the table on page 19.

Appl. No. : 10/764,012  
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New claim 46 is supported by the specification at the table on page 19.

New claim 47 is supported by the specification at the table on page 19.

No new matter has been added.

ANTICIPATION REJECTION OVER DEAYER U.S. Patent No. 4,005,035

In paragraph 5 of the Office Action, the Examiner has rejected claims 1-5 and 7-9 under 35 U.S.C. § 102(b) as anticipated by Deaver (U.S. Patent No. 4,005,035). Applicant respectfully traverses this rejection, and requests reconsideration and withdrawal thereof.

The Examiner cites the portion of the Deaver disclosure from the abstract and column 3, line 41 through column 4, line 2 as anticipating Applicant's claims. However, this cited portion of Deaver does not disclose the use of a first polyol having a first molecular weight and a second polyol having a second molecular weight which is less than the first molecular weight, which are used in the formation of a polyurethane that is less rigid than a polyurethane formed from only the first polyol.

The Examiner dismisses any differences between the disclosure of Deaver and the claims as "method limitations [that] do not determine the patentability of the product, unless the process produces unexpected results," citing MPEP § 2113. However, the claim limitations ignored by the Examiner are not mere process limitations in a product-by-process claim to a product that is otherwise the same as that disclosed in the prior art (but produced by a different process). Instead, Applicant's product as claimed in Claim 1 is materially different at least in part because of the specific polyols used in its formation. The combination of polyols recited in Claim 1 results in the formation of a polyurethane which is less rigid than a polyurethane that would be formed by only the first polyol. Thus, the final polyurethane product as a result of the combination is materially different from the polyurethane products described in Deaver.

The Examiner's failure to accord any weight to the claimed recitation of the particular polyols that react to form the claimed polyurethane constitutes a failure to give weight to differences between the claimed polyurethane, per se, and that disclosed in Deaver. Deaver discloses that "[f]or the formation of a rigid polyurethane foam a highly branched polyol should be used having a molecular weight . . . of about 300 to about 800." Deaver does not disclose a way to control the flexibility of the polyurethane composite by the addition of another polyol of

**Appl. No.** : 10/764,012  
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different molecular weight. When appropriate weight is given to the recited claim limitation, it is clear that Deaver does not disclose a single embodiment that contains all of the elements recited in Applicant's claims. Absent such a disclosure, Deaver cannot anticipate Applicant's Claim 1. Claims depending from Claim 1 are patentable at least for the reasons noted above for Claim 1 and also because they recited novel and nonobvious combinations of elements.

Appl. No. : 10/764,012  
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### III CONCLUSION

Applicant respectfully submits that the present claims are in condition for immediate allowance, and an early notification to that effect is earnestly solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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